

Remarks

The Official Action dated May 18, 2004 has been carefully reviewed. In view of the amendments submitted herewith and the following remarks, favorable reconsideration and allowance of this application are respectfully requested.

At the outset it is noted that a shortened statutory response period of three (3) months was set in the May 18, 2004 Official Action. Therefore, the initial due date for response was August 18, 2004. A petition for a two (2) month extension of the initial response period is presented with this request for reconsideration which is being filed before the expiration of the two (2) month extension period.

At page 2 of the Official Action, the Examiner has rejected claims 29-35, 37, 48, 64-70, 73 and 74 under 35 U.S.C. §112, second paragraph as allegedly indefinite for failing to particularly point out and distinctly claim the subject matter regarded as the invention. Specifically, the Examiner finds that the phrase "transcription expression" lacks clarity. The claims have been amended to indicate that the nucleic acid is expressed in the plant cell, thereby removing any perceived ambiguity from the claim. Accordingly, Applicants request that the §112, second paragraph rejection of the aforementioned claims be withdrawn.

Claims 29-35, 37, 48, 64-70 and 72-74 stand rejected under 35 U.S.C. §112, first paragraph as allegedly containing subject matter which was not described in the specification in such a way as to reasonably convey that the inventors had possession of the invention at the time the application was filed.

The Examiner has also rejected claims 29-35, 37, 48, 64-70 and 72-74 asserting that the specification fails to adequately enable the claimed subject matter.

At page 7 of the Official Action, the Examiner as rejected claim 72 under 35 U.S.C. §102(b) as allegedly anticipated by WO 90/12084 to Jorgensen et al. This claim has been canceled in accordance with the present amendment, thereby rendering this rejection moot.

In addition, existing claims 64, 71, 73 and 74 have also been canceled. The cancellation of claims 64 and 71-74 should not be construed as indicative of Applicants concurrence or acquiescence in the various rejections thereof as set forth in the May 18, 2004 Official Action, or otherwise as an abandonment of Applicants efforts to secure patent protection on the subject matter of those claims. To the contrary, Applicants vigorously dispute those grounds of rejection. Such arguments as Applicants have to advance in rebuttal, however, are being reserved for a continuing application, which is expected to be filed and will include claims directed to some or all of the subject matter of canceled claims 64, and 71-74.

Applicants submit that the claims as presently amended are in condition for allowance. Each of the above-noted rejections is traversed for the reasons set forth below.

THE SUBJECT MATTER OF CLAIMS 29-35, 37, 48 AND 65-70 AS AMENDED IS FULLY ENABLED AND DESCRIBED IN THE SPECIFICATION AS FILED

The Examiner has rejected claims 29-35, 37, 48, 64-70 and 72-74 under 35 U.S.C. §112, first paragraph asserting that the specification does not provide an adequate written description of the subject matter encompassed by these claims. Specifically, the Examiner objects to the inclusion of sequences having 80% identity to the sequence which encodes SEQ ID NO: 2 in claim 29. It is the Examiner's position that Applicants have not described nucleic acid sequences having this characteristic. Applicants disagree.

As noted in the MPEP at § 2163,

To satisfy the written description requirement, a patent specification must describe the claimed invention in sufficient detail that one skilled in the art can reasonably conclude that the inventor had possession of the claimed invention.

Furthermore, the written description guidelines set forth in the Federal Register Vol. 66, No. 4, January 5, 2001 state that "An adequate written description of the invention may be shown by any description of sufficient, relevant, identifying characteristics, so long as a person skilled in the art would recognize that the inventor had possession of the claimed invention." (page 1105, column 3). "An applicant may also show that an invention is complete by disclosure of sufficiently detailed, relevant identifying characteristics which provide evidence that the applicant was in possession of the claimed invention, ie: complete or partial structure, other physical and/or chemical properties, functional characteristics when coupled with a known or disclosed correlation between function and structure, or some combination of characteristics." (Page 1106, column 1).

The claims require that the recited sequence encodes a protein which possesses RdRP activity **AND** is 80% identical to SEQ ID NO:1 or a sequence which hybridizes to SEQ ID NO: 1 under stringent conditions. Such a sequence is fully described in the specification.

Claims 29-35, 37, 48, 64-70 and 72-74 are also rejected under 35 U.S.C. §112, first paragraph. It is the Examiner's position that the specification does not provide enablement for a sequence which is 80% identical to SEQ ID NO: 1 which causes a reduction in the synthesis of RdRP. Applicants respectfully submit that the skill in the art of molecular biology and the creation of transgenic plants is quite high. The skilled artisan in this field could readily generate sequence variants of SEQ ID NO: 1 which are 80% identical to the reference sequence and test them for RdRP

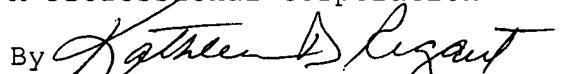
activity based on the disclosure provided in the specification without undue experimentation. Nothing more is required under 35 U.S.C. §112, first paragraph. However, in the interest of expediting prosecution of the present application, the language pertaining to sequences having 80% identity to SEQ ID NO: 1 has been removed from the claims. Applicants respectfully submit that this amendment eliminates the Examiner's grounds for rejecting the claims. Accordingly, Applicants request that the rejection of the claims under 35 U.S.C. §112, first paragraph be withdrawn.

It is respectfully requested that the amendments presented herewith be entered in this application, since the amendments are primarily formal, rather than substantive in nature. This amendment is believed to clearly place the pending claims in condition for allowance. In any event, the claims as presently amended are believed to eliminate certain issues and better define other issues which would be raised on appeal, should an appeal be necessary in this case.

CONCLUSION

The present communication is completely responsive to the issues raised in the Official Action of May 18, 2004. Applicants believe that the claims as they stand are in condition for ready allowance. In the event the Examiner is not persuaded as to the allowability of any claim, and it appears that any outstanding issues may be resolved through a telephone interview, the Examiner is requested to telephone the undersigned attorney at the phone number given below.

Respectfully submitted,
DANN, DORFMAN, HERRELL AND SKILLMAN
A Professional Corporation

By 
Kathleen D. Rigaut, Ph.D., J.D.
Registration No. 43,047

Telephone: (215) 563-4100